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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,704	04/05/2007	Lionel Marcon	403794	9140
23548	7590	11/03/2008		
LEYDIG VOIT & MAYER, LTD			EXAMINER	
700 THIRTEENTH ST. NW				DEXTER, CLARK F
SUITE 300			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005-3960			3724	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/598,704	MARCON, LIONEL
	<b>Examiner</b>	<b>Art Unit</b>
	Clark F. Dexter	3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 August 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4-7,11,12 and 14-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,4-7,11,12,14-18 and 20-22 is/are rejected.  
 7) Claim(s) 19 and 23-25 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 August 2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. The amendment filed on August 8, 2008 has been entered.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

It is noted that the Application Data Sheet filed on April 5, 2007 has been received but is NOT acceptable because it is not titled “Supplemental Application Data Sheet” as required (see 37 CFR 1.76 (c)(2)). To obviate this matter, applicant may either file a supplemental declaration or a supplemental application data sheet.

### ***Drawings***

3. The drawings were received on August 8, 2008. These drawings are NOT acceptable for the following reasons. While the addition of numeral 18 is acceptable, the proposed changes to the specification render the disclosure more unclear than the previous version, and the drawings remain objected to as described in the previous Office action and as further described below.

4. The drawings are objected to because of the following informalities:

In Figure 5, numeral 18 should be added to represent the spring; further, the figure should be amended as follows:

for branch 14 (and corresponding disk 44), numeral 12 should be added to indicate the hole near the top of branch 14, numeral 16 should be added to indicate the branch end of branch 14, numeral 46 should be added to indicate the pin located within hole 12, and another occurrence of numeral 46 should be added to indicate the pin shown within the bowed out portion of 14 (located below the lead line for numeral 5);

for branch 15 (and corresponding disk 45), the upper occurrence of numeral 12 should be changed to --13-- to indicate the hole near the top of branch 15, numeral 17 should be added to indicate the branch end of branch 15, the lower occurrence of numeral 12 is inaccurate and should be deleted, and a second occurrence of numeral 46 should be added to indicate the pin shown within the bowed out portion of 15 (through which the lead line of the lower occurrence of 12 extends).

Additionally, in each of Figures 1-4, upon further consideration, the following changes should be made for clarity and accuracy: numeral 12 should be changed to --12, 46-- to accurately reflect that both the hole 12 and one of the pins 46 is shown.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

5. The disclosure is objected to because of the following informalities:

In paragraph 0028, line 3, "15" is inaccurate and should read -14-; in line 4, "14" is inaccurate and should read --15--.

In paragraph 0029, the changes render the description unclear and confusing and are not acceptable, and it is suggested to restore this paragraph to its original form with the changes suggested in the previous Office action.

In paragraph 0030, line 6, the recitation "pins in the holes 12" is unclear and confusing and should be changed to --pins 46 in the holes 12 and 13—for clarity and accuracy.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

6. Claims 1, 2, 4-7, 11, 12, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, the recitation "the first second levers" lacks antecedent basis.

In claim 7, line 4, the recitations "the pins" and "the holes" each lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Bonito et al., pn 2,968,096.

Bonito discloses a pliers with every structural limitation of the claimed invention including:

a first lever (e.g., 2) and a second lever (e.g., 12) articulated together on a pivot axis (e.g., at 10) for pivoting between an open position for receiving a tube which is to be cut and a closed position after cutting of the tube, wherein  
the second lever includes a blade (e.g., 19),  
the first lever includes

a rotary shaft (e.g., 3), and  
a substantially planar wheel (e.g., 6, which is “planar” is at least the same manner as the wheel 4, 44, 45 of the present invention) rotatably mounted on the rotary shaft and having a periphery including a plurality of grooves (e.g., see col. 2, lines 37-39) having respective, different widths for receiving tubes of different diameters so that a groove selected according to the diameter of a tube to be cut can be placed opposite the blade when the wheel is turned to a corresponding position.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 4, 17, 18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonito et al., pn 2,968,096 alone or alternatively, in view of one or both of McMurtrie pn 560,524 and Bradley, pn 3,543,616.

Regarding claims 1 and 4, Bonito discloses a device with almost every structural limitation of the claimed invention (with the lacking structure being indicated by strikethrough and grayed-out) including:

a first lever (e.g., 2) and a second lever (e.g., 12) articulated together on a pivot axis (e.g., at 10) for pivoting between an open position for receiving a tube which is to be cut and a closed position after cutting of the tube, wherein

the second lever includes a blade (e.g., 19),

the first lever includes

a rotatable shaft (e.g., 3) ~~parallel to the pivot axis of the first second levers~~,

and

a wheel (e.g., 6) rotatably mounted on rotary shaft and having a periphery including a plurality of grooves (e.g., see col. 2, lines 37-39) having respective, different widths for receiving tubes of different diameters so that a groove selected according to the diameter of a tube to be cut can be placed opposite the blade when the wheel is turned to a corresponding position;

[claim 4] wherein the wheel includes two disks that are parallel to one another, mounted coaxially on the rotary shaft, and spaced from one another on the rotary shaft (e.g., it can be argued that there are a plurality of integral disks disclosed, and outer disks are spaced from one another by inner disks).

Further, regarding claim 20, Bonito discloses a device with almost every structural limitation of the claimed invention (with the lacking structure being indicated by strikethrough and grayed-out) including:

a first lever (e.g., 2) and a second (e.g., 12) lever articulated together on a pivot axis (e.g., at 10) for pivoting between an open position for receiving a tube which is to be cut and a closed position after cutting of the tube, wherein

the second lever includes a blade (e.g., 19),

the first lever includes

a rotary shaft (e.g., 3), and two substantially planar disks (e.g., it can be argued that there are a plurality of integral disks disclosed) rotatably and coaxially mounted on the rotary shaft ~~and spaced from each other~~, each disk having a periphery including a plurality of grooves having respective, different widths for receiving tubes of different diameters so that a groove selected according to the diameter of a tube to be cut can be placed opposite the blade when the disks are turned to a corresponding position.

Regarding claims 1, 18 and 22, Bonito lacks the rotatable shaft being parallel to the pivot axis of the first and second levers. However, as stated in the previous Office action, to orient the shaft, and thus both shafts, of the pliers such that they are parallel to the pivot axis would have been the mere discovery of the optimum or workable ranges of shaft orientations within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art. If evidence of such a well known configuration is determined to be necessary, McMurtrie and Bradley are just two examples of patents that teach or suggest such a parallel shaft orientation.

Regarding claims 2, 17 and 21, Bonito discloses a pliers with almost every structural limitation of the claimed invention but lacks a blade having two adjoining cutting edges intersecting at an outwardly projecting point as claimed. However, the Examiner takes Official notice that such blades are old and well known in the art and provide various well known benefits including making available a fresh cutting edge after one adjacent thereto becomes worn or damaged. Therefore, it would have been

obvious to one having ordinary skill in the art to provide such a blade on the pliers of Bonito to gain the well known benefits including that described above.

Regarding claim 4, in the alternative, if it is argued that Bonito does not sufficiently teach or suggest the specific claimed disk configuration, it would have been obvious to one having ordinary skill in the art to construct the plurality of integral rings such that they are separate disks to gain well known benefits including facilitating replacing the rings or changing out the rings for different sizes.

Regarding claim 20, Bonito lacks the two substantially planar disks (e.g., it can be argued that there are a plurality of integral disks disclosed) with a plurality of grooves being spaced from each other. However, to simply provide additional grooves (and thus provide a plurality of grooved portions separated by a portion having at least one groove) by either elongating the shafts and roller or by providing more grooves in the existing roller configuration would have been obvious to one having ordinary skill in the art for various well known reasons, particularly to facilitate cutting a larger range or a larger number of wire diameters.

#### ***Allowable Subject Matter***

11. Claims 19 and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 5-7, 11, 12, 14 and 15 appear that they would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

13. Applicant's arguments filed August 6, 2008 have been fully considered but they are not persuasive.

In the paragraph bridging pages 13-14 of the subject amendment, applicant argues that:

"The blade is and must be aligned perpendicular to the shaft 3 to accomplish its function."

It is respectfully submitted that the Examiner agrees with applicant's position, and that applicant's position is not contrary to the modification suggested in the prior art rejection. What is critical is that the blade is parallel with the grooves (i.e., perpendicular to the shaft 3). In the prior art rejection, it is suggested that it would be obvious to simply reposition both shafts so that they are parallel with the claimed axis (e.g., that axis at 10). In such a repositioning, the blade would remain perpendicular to the shaft 3.

In the third paragraph on page 14 of the subject amendment, and in the paragraph bridging pages 14-15 of the subject amendment, applicant alleges that the repositioning of the shafts in the manner suggested in the prior art rejection would cause negative operational effects. The Examiner respectfully disagrees with applicant's position. First, it is respectfully submitted that applicant's allegations are merely

speculative. Second, there are a number of prior art devices that have shafts positioned in the manner suggested in the prior art rejection. Two examples, McMurtrie and Bradley, of such prior art devices have been provided which demonstrate that such a configuration is old and well known in the art. Further, these examples demonstrate at least a portion of an established working range as well as an optimization thereof.

Thus, for at least these reasons, it is respectfully submitted that applicant's arguments cannot be considered to be persuasive and that the subject claims cannot be considered to be allowable over the prior art of record.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cf  
October 30, 2008